

## **REMARKS**

Applicant respectfully requests reconsideration of the subject application.

### **1. Election of Invention to be Examined**

The Examiner requires restriction to one of Group I (Claims 1-59) and Group II (Claims 60-92). In response thereto, Applicant confirms provisional election, without prejudice and with traverse, of Group I (Claims 1-59), for prosecution on the merits.

Applicant respectfully traverses the restriction for at least the following reason. MPEP § 803 states that “[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.” As such, Applicant respectfully submits that examination of entire application can be made without a serious burden and would not require an additional search outside of the field or fields searched in and for the examination of Group I and, therefore, the examiner should examine it on the merits even if it claims independent and distinct inventions.

### **2. 35 U.S.C 103(a) Rejections**

Claims 1-4, 17, 22-25 and 41-44 stand rejected as being unpatentable over Henon (U.S. Patent 6,577,717) in view of Kazmi (U.S. Patent No. 6,044,261). Claims 5-11, 13-16, 19-21, 26-31, 33-36, 38-40, 45-50, 52-55 and 57-59 stand rejected as being unpatentable over Henon in view of Kazmi and in further view of Marsh (U.S. Patent No. 6,574,465). Claims 12, 32 and 51 stand rejected as being unpatentable over Henon in view of Kazmi and in further view of Chung (U.S. Patent No. 6,532,366). Claims 18, 37 and 56 stand rejected as being unpatentable over Henon in view of

Kazmi and in further view of Dahm (U.S. Patent No. 6,597,903). Applicant respectfully traverses these rejections for at least the reasons below.

35 U.S.C. 103(a) sets forth in part:

[a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Hence, to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure re *Vaeck*, 947 F2d 488, 20 USPQ2d 1438 (Fed. Cir. 1999).

**A. *Henon and Kazmi fail to teach the use of flat rate and pay-in-advance services***

Claims 1, 22 and 41 each recite, in part, "determining a flat rate charge for the services . . . and receiving payment of the charge substantially before the wireless communications services are rendered to the subscriber." Support for this limitation can be found on page 53 of the specification where it recites, by way of non-limiting example only:

The operations of the present invention involve a number of improvements relative to prior known cellular systems. The billing system is modified and improved. The format, customer service screens and interfaces, and return and repair functions are improved. Simplified "one-line billing" is preferred. The billing is based upon a flat rate for cellular service. Preferably, the rate is low enough to attract additional users who are eliminated by traditional metered billing formats based upon minute of use charges. Payment is requested in advance, eliminating or substantially reducing accounts receivable. Service is terminated for non-payment, eliminating or reducing collections operations.

Applicant respectfully submits, in light of the recitation immediately above, that Henon and Kazmi fail to teach the use of flat rate and pay-in-advance services. Applicant submits Henon merely teaches the use of variable rate, pay-as-you-go calling plans that alert customers to rates and charges, each of which change periodically throughout a given day. (see Henon, col. 4, lines 39-51). Specifically, Henon teaches:

In an embodiment of the invention the subscriber station has a user-friendly interface for processing received service charging tariff information. In such a user-friendly interface service charging information is displayed in the form of an icon, such as a triangle, or a bar chart, or the like reflecting different tariff periods and tariffs throughout the day. Herewith, the subscriber has a convenient

means to decide whether to immediately place a call, possibly against higher costs, or, based on the displayed information, to postpone a call to a later time. (col. 3, lines 37-46).

Thus, Applicant respectfully submits that Henon teaches, as stated in Henon, the *informing* of a mobile subscriber of a change in the tariff charge for a particular call, thereby allowing the subscriber to either place a call for which the subscriber will be charged the given tariff after the call is made, or not to choose to incur the tariff by not placing the call at that time.

Further, Applicant respectfully submits Kazmi, like Henon, merely teaches the *informing* of a subscriber of a change in the variable charging rate depending on the subscriber's location. (see Kazmi, col. 6, lines 43 – 54). Kazmi teaches:

Due to its different sizes and locality, each home zone is further associated with a different charging rate. For a smaller home zone covering the place of work, a lower charging rate may be applied. For a larger geographic area or high traffic capacity area, a higher charging rate can be accordingly assigned. An increase in feature subscription fees can further be levied for an increase in the number of home zones associated with a particular subscription. For calculating fees for the particular subscription, a centralized billing center can then utilize the associated billing rates for different home zones utilized by the mobile subscriber. (col. 7, lines 39-50).

(Applicant thus respectfully submits that Kazmi merely teaches charging a mobile subscriber a variable rate dependant on location of the subscriber, and informing of the subscriber of the associated rate changes. In other words, Applicant submits Henon and Kazmi, neither individually nor in combination, teach or suggest the use of flat rate and pay-in-advance services for subscribers in wireless communication services.)

Wherefore, Applicant submits at least Claims 1, 22 and 41 are patently distinguishable over the prior art of record. Applicant further submits each of Claims 2-

21, 23 - 40 and 42 - 59 is similarly distinguishable over the prior art of record, at least by virtue of each Claim's ultimate dependency from a patentably distinct base Claim 1, 22 or 41.

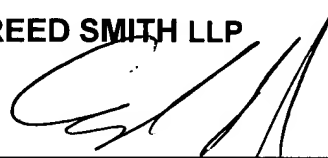
### **Conclusion**

Wherefore, Applicant believes all outstanding grounds raised by the Examiner have been addressed, and thus respectfully submits the present case is in condition for allowance, early notification of which is earnestly solicited.

Alternatively, should the Examiner persist in any of the foregoing rejections, Applicant respectfully requests the Examiner: specifically identify and point out with particularity those exacting elements taught by the prior art references upon which the Examiner relies for teaching each claimed element of each rejected claim; and, identify those particular portions of the prior art references upon which he relies for support, so Applicant may be afforded an appropriate opportunity to deliberate and respond to any such rejection.

Respectfully Submitted,

**REED SMITH LLP**



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